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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,014	08/07/2006	Hirokazu Mihashi	MURA-100	7033
217 7590 11/20/2009 FISHER, CHRISTEN & SABOL 1120 20TH STREET, NW, SOUTH TOWER, SUITE 750 WASHINGTON, DC 20036				
EXAMINER				
BOMBERG, KENNETH				
ART UNIT		PAPER NUMBER		
3754				
MAIL DATE		DELIVERY MODE		
11/20/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/575,014

**Applicant(s)**

MIHASHI ET AL.

**Examiner**

KENNETH BOMBERG

**Art Unit**

3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 July 2009.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-3 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 07 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/22)  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2002/0130139 to Shiraishi et al. (Shiraishi) in view of US Patent 5,497,910 to Meadows et al (Meadows).

#### **In Reference to Claim 1**

Shiraishi teaches:

A discharging container with a filter (1) comprising:

a bottle (2) which is formed in a manner wherein an inner layer (22) peelable from an outer layer (21) is formed on an inner surface of the outer layer;  
a plug body (3) placed on a mouth portion (2a) of the bottle; and  
a filter provided (7) in a discharging pass (10) which is provided in the plug body for discharging liquid kept in a body of the inner layer;

Shiraishi further teaches:

a dispensing valve (8) has a memory which expands the valve in a manner wherein a difference between an inner negative pressure and an ambient air is higher than a filtration resistance of the filter (see page 6, [0075] last 7 lines); and  
the negative pressure is caused by the memory of the valve (8) and by that liquid remained in a second side of the filter is sucked into a primary side of the filter (see [0043] and [0053]).

Shiraishi differs from the claim in that it is the resilient dispensing valve (8) and its associated connector sleeve (83) which causes the remaining liquid to be sucked into a primary side of the filter rather than the memory of inner layer (22) which is disclosed to be made of a synthetic resin made of a resilient material (see [0057] and [0060]).

Meadows teaches:

In Figs. 1-3 of a dispenser similar to that of applicants' and Shiraishi to make an inner layer (inner bottle 30) from a resilient (compressible) material (LDPE) configured so as to create a "suck back" vacuum (see col. 4, lines 57-62; col. 5, lines 35-43).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have applied the teaching of using the characteristics of the compressible inner bottle to suck back liquid into the inner layer of Meadows in the dispenser of Shiraishi because doing so would allow the suck back function to be performed without the use of a resilient valve.

Further the application of the teaching of Meadows to Shiraishi constitutes no more than combining prior art elements according to known methods to yield predictable results and the use of a known technique to improve similar device in the same way supporting a conclusion of obviousness in accordance with the guidance of *KSR International Co. v. Teleflex Inc.* (KSR), 550 U.S. \_\_\_, 82 USPQ2d 1385

In Reference to Claim 2

See Shiraishi [0067].

In Reference to Claim 3

See Shiraishi Fig. 1.

***Response to Arguments***

4. Applicant's arguments filed July 2, 2009 have been fully considered but they are not persuasive.

In response to the Examiner's notification in paragraph 1 that the listing of references in the specification is not a proper information disclosure statement, Applicant argues that the examiner is required to read and consider all of the disclosure in the application, including the

prior art disclosed and discussed in the application. The disclosure has been considered including Applicant's description of the background art; however, considering Applicant's description of a reference is not equivalent to considering the reference itself. Consequently references which were not indicated as being considered in the Notice of References Cited or the Information Disclosure Statement have not been considered.

Page 4 of Applicant's Remarks / Arguments states:

A very important feature of the claimed invention of this application is the relationship between the expanding memory of the inner layer and the filtration resistance of the filter. The combination of the two rejection references does not result in applicants' claimed invention. Shiraishi et al. does not disclose that its inner layer has expanding memory. Meadows et al. does not disclose use of a filter. All of the disclosure of the rejection references (and other prior art of record) has to be considered under Section 103(a). Since Meadows et al. does not use a filter, the combination of Shiraishi et al. and Meadows et al. would not use a filter. [The Examiner has no basis of fact and/or law in the record to assert that the lack of a filter in Meadows et al. would have to give way to the use of a filter by Shiraishi et al. - to contend otherwise is mere hindsight and speculate by the Examiner. The Examiner has no basis (in the record) under Section 103(a) to choose one combination over the other. Section 103(a) requires facts, not speculation and hindsight.]

These arguments are not found persuasive for several reasons. First, these arguments amount to a piecemeal analysis of the references; one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Second, the obviousness rejection is being mischaracterized; the rejection is based on Shiraishi et al. as modified by the teachings of Meadows et al., not vice versa as argued. Third the reason for the modification as set forth in the rejection is based upon the teaching of Meadows et al.

In the paragraph spanning pages 5-6, Applicants argue that Shiraishi et al. fails to suggest

the expanding memory feature of the inner layer. This statement is factually incorrect; Shiraishi et al. clearly indicates the bag / inner layer (22) is made of a synthetic resin made of a resilient material (see [0057] and [0060]) which as described has a "memory". Meadows provides the further teaching to provide such a bag /inner layer with sufficient resilience to result in a suck back effect.

On pages 6-7, the applicant argues that "The Examiner has not factually resolved the level of ordinary skill in the art so the Examiner has no basis in the record for asserting/stating what would be obvious to one ordinarily skilled in the art." Although it is not clear what precisely is meant by this statement as applied to the rejection of record, as best understood it appears to be based on a misconception of the requirement for deterring the level of ordinary skill in the art. Applicant's attention is directed to MPEP 2121.03 which states:

The "hypothetical" person having ordinary skill in the art' to which the claimed subject matter pertains would, of necessity have the capability of understanding the scientific and engineering principles applicable to the pertinent art." *Ex parte Hiyamizu*, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Inter. 1988) (The Board disagreed with the examiner's definition of one of ordinary skill in the art (a doctorate level engineer or scientist working at least 40 hours per week in semiconductor research or development), finding that the hypothetical person is not definable by way of credentials, and that the evidence in the application did not support the conclusion that such a person would require a doctorate or equivalent knowledge in science or engineering.); and

If the only facts of record pertaining to the level of skill in the art are found within the prior art of record, the court has held that an invention may be held to have been obvious without a specific finding of a particular level of skill where the prior art itself reflects an appropriate level. *Chore-Time Equipment, Inc. v. Cumberland Corp.*, 713 F.2d 774, 218 USPQ 673 (Fed. Cir. 1983). See also *Okajima v. Bourdeau*, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001).

In the rejection of record, the prior art itself is directed to the same field of endeavor (dispensing containers), and clearly indicates that one having ordinary skill in this art understands that a container can be configured to provide a suck-back feature through a dispensing outlet and a

dispensing outlet having a filter, and further that the resilience of an inner container may be used to create this suck-back effect. In view of the above, it is unclear how the rejection could be construed as being deficient in ascertaining the ordinary level of skill in the art.

It is further argued that rejection fails to factually establish “predictable results” when applying the teaching of Meadows to Shiraishi and the rejection therefor is based on forbidden hindsight. As with the previous argument, it is not clear what precisely is meant by this statement as applied to the rejection of record. The teachings of Meadows in using the resilience of the inner container to obtain the suck back effect are clear. Similarly, the fact that Shiraishi includes a resilient inner container but discloses the valve as being used to obtain the desired suck back is also clear. What exactly is unpredictable about applying the Meadows teaching of using the inner bag to assist or obtain the desired suck back in Shiraishi is unclear. The level of ordinary skill in the art as demonstrated by Shiraishi and Meadows clearly indicates that making an inner bag which is already disclosed as being resilient (by Shiraishi) sufficiently resilient to assist / perform the suck back function as explicitly taught by Meadows would produce the desired results through routine experimentation.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after



the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENNETH BOMBERG whose telephone number is (571)272-4922. The examiner can normally be reached on Monday-Thursday and alternative Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on (571)272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KB  
/Kenneth Bomberg/  
Primary Examiner, Art Unit 3754